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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,893	01/08/2002	John C. Peiffer	20004/1-US	8949

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EXAMINER	
SAUNDERS JR, JOSEPH	
ART UNIT	**PAPER NUMBER**
2615	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/973,893	PEIFFER ET AL.	
	Examiner	Art Unit	
	Joseph Saunders	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *83-85,87 and 88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *83-85,87 and 88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 August 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communications filed April 28, 2008. Claims 83 – 85, 87, and 88 are currently pending and considered below.

Response to Arguments

2. Applicant's response, see page 3 paragraph 2, filed April 28, 2008 regarding the provisional double patenting rejection of the office action dated January 7, 2008 is noted and rejection is maintained below.

3. Applicant's arguments, see page 3 paragraph 3, filed April 28, 2008, with respect to claims 83 – 85 have been fully considered and are persuasive. The rejection dated January 7, 2008 of claims 83 – 86 under 35 U.S.C. 112, first paragraph and second paragraph has been withdrawn.

4. Applicant's arguments, see page 3 paragraph 4 through page 5, filed April 28, 2008, with respect to the rejection(s) of claim(s) 83 – 85 under 35 U.S.C. 102 as being anticipated by Truman et al. (US 6,807,528 B1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Naimpally et al. (US 5,650,825).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 83 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 18, 19, 34, 35, 50, 57, 65, and 69 of copending Application No. 11/237,251. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 83, Application No. 11/237,251 discloses a method of inserting data in a compressed data bitstream, comprising: repacking ("time shifting") first data in a first portion of the compressed data bitstream to increase a size of a second portion of the compressed data bitstream; and inserting second data in the second portion of the compressed data bitstream to form a modified compressed data bitstream (see claims 1). Claims 18, 34, 50, 57, 65, and 69 also disclose the method and therefore also anticipate claim 83.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 83 – 85, and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Naimpally et al. (US 5,650,825), hereinafter Naimpally.

Claim 83: Naimpally discloses a method of inserting data in a compressed data bitstream ("method and apparatus for sending private data instead of stuffing bits in an MPEG bit stream"), comprising: repacking first data in a first portion ("stuffing bytes are removed from a payload portion") of the compressed data bitstream to increase a size of a second portion ("header portion") of the compressed data bitstream; and inserting second data in the second portion ("privatestuff data is inserted into the header portion") of the compressed data bitstream to form a modified compressed data bitstream (Column 3 Lines 38 – 42 and Figures 3 and 8A – 8C).

Claim 84: Naimpally discloses a method as defined in claim 83, further comprising examining a frame within the compressed data bitstream to determine a number of skip bytes ("stuffing bytes") within the frame (Figures 4A and 4B).

Claim 85: Naimpally discloses a method as defined in claim 84, wherein repacking the first data in the first portion of the compressed data bitstream includes repacking the first data based on the number of skip bytes within the frame (Data in the payload portion is repacked based on the number of stuffing bytes removed decreasing the size of the payload portion and increasing the size of the header portion, see Figures 3 and 8A – 8C).

Claim 88: Naimpally discloses a method as defined in claim 83, wherein the second portion ("header portion") of the compressed data bitstream comprises an auxiliary data field ("adaptation field", Figure 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naimpally in view of Truman et al. (US 6,807,528 B1), hereinafter Truman.

Claim 87: Naimpally discloses a method as defined in claim 83, but does not disclose wherein the first portion of the compressed data bitstream comprises one or more audio blocks. Naimpally does disclose "the syntax for the MPEG-2 standard defines several

layers of data records which are used to convey both audio and video data. For the sake of simplicity, the decoding of the audio data is not described herein," Column 1 Lines 47 – 50. Truman discloses a similar method of adding data to a compressed data frame and teaches "Many low bit rate digital audio encoding systems, including Dolby Digital and MPEG-2 AAC generate data streams in which unused bits exist whenever the bit allocation function in the encoder does not utilize all available bits from a bit pool for encoding the audio signal. This occurs if the final bit allocation falls short of using all available bits or if the input audio does not require all available bits. Such unused bits (often referred to as dummy, fill, stuffing, or null bits) are wasted bits that carry no useful information," Column 1 Lines 5 – 16. Truman further illustrates a simplified conceptual depiction of a Dolby Digital serial coded audio bitstream where the payload portion comprises "audio blocks" AB 0 – AB 5, Figure 2. Therefore, while Naimpally discloses as an example that the first portion or "payload portion" of the MPEG-2 bitstream is video data; since Naimpally states "For the sake of simplicity, the decoding of the audio data is not described herein," it would have been obvious to one of ordinary skill in the art at the time of the invention that given the similarity between Naimpally's and Truman's teachings to apply the teachings of Naimpally to an MPEG-2 bitstream or similar bitstream where the payload portion comprises audio blocks as disclosed by Truman.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Suhan Ni can be reached on (571) 272-7505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./
Examiner, Art Unit 2615
/Suhan Ni/
Primary Examiner, Art Unit 2614